

REMARKS

Claims 2-10 are pending in the present application and are rejected. Claims 2, 5 and 8 are herein amended. New claims 11-13 are added herein.

Applicants' Response to Claim Rejections under 35 U.S.C. §102

Claims 2-10 were rejected under 35 U.S.C. §102(b) as being anticipated by Guo et al. (AN: 1994: 692369, abstract, Chinese Pharmaceutical Journal).

It is the position of the Office Action that Guo discloses the embodiments as claimed. Guo discloses a compound meeting formula (1), and that this compound produced hypoglycemic and antiplatelet activity in an animal model. Although Guo does not disclose any role of the compound in osteoporosis, the Office Action alleges that Guo inherently discloses this, and thus anticipates the claims.

Claim 2 recites “treating” and “preventing.” The Office Action interprets “prevent” to mean “anticipate or counter in advance, to keep from happening.” The Office Action regards prevention of osteoporosis as being inherent to the method of administering the same compound in an overlapping dosage amount to the same patient population. In essence, it appears to be the position of the Office Action that patients in Guo who receive the compound for purposes unrelated to osteoporosis will inherently receive an anti-osteoporosis effect. As such, it appears to be the position of the Office Action that Guo can be broadly interpreted as inherently disclosing a method of preventing osteoporosis as claimed.

As to treatment of osteoporosis, Guo cannot be interpreted as inherently or explicitly disclosing this. Since Guo does not disclose patients who are suffering from osteoporosis, it cannot disclose treatment of osteoporosis. However, since claim 2 recites “treating” and “preventing” in the alternative, the Office Action only addressed “preventing.” Therefore, Applicants herein amend claim 2 to recite only a method of “treating” osteoporosis. Additionally, Applicants herein amend claim 2 to recite a step of identifying a patient having osteoporosis. Applicants respectfully submit that Guo does not inherently or explicitly disclose or suggest this subject matter.

As to prevention of osteoporosis, Applicants herein add a new independent claim which specifically addresses this. Please see new claim 11, and the claims dependent thereon. Applicants note that this claim recites a step of “identifying a patient in need of osteoporosis prevention.” Applicants note that only a particular group of people (*i.e.*, post-menopausal women, people with hormonal disorders, etc.) are “in need of osteoporosis prevention.” In other words, the method of new claim 11 is directed at prevention of osteoporosis in people who are at risk of osteoporosis, rather than in people generally. Since Guo only identifies animal models generally, it does not inherently or explicitly disclose the recited prevention.

Next, Applicants discuss claim 5, which recites a method of inhibiting bone resorption. Osteoporosis is due to an imbalance in the ratio of bone resorption and bone formation. In normal, non-osteoporotic bone, bone resorption and bone formation occur at approximately equal rates. However, in osteoporosis, bone resorption occurs at a significantly greater rate than bone formation. As such, in all people, bone resorption is constantly occurring. However, inhibition

of bone resorption is only needed in patients suffering from osteoporosis. In other words, a patient “in need of bone resorption inhibition” is a patient already suffering from osteoporosis. Thus, claim 5 recites a more specific method of treating osteoporosis, which is not explicitly or inherently disclosed or suggested by Guo. Accordingly, Applicants herein amend claim 5 to recite “identifying the patient in need of bone resorption inhibition.” Since Guo only identifies animal models generally, and does not state that any of the animal models are “in need of bone resorption inhibition,” Applicants respectfully submit that Guo does not inherently or explicitly disclose the recited method.

Finally, Applicants discuss claim 8, which recites a method of improving bone formation. Applicants amend claim 8 in a manner similar to claim 5, above. Improvement of bone formation is only needed in patients suffering from osteoporosis. In other words, a patient “in need of bone formation improvement” is a patient already suffering from osteoporosis. Thus, claim 8 recites a more specific method of treating osteoporosis, which is not inherently or explicitly disclosed or suggested by Guo. Additionally, Applicants herein amend claim 8 to recite “promotion” instead of “improvement,” since this appears to be the more appropriate word. Accordingly, Applicants herein amend claim 8 to recite “identifying the patient in need of bone formation promotion.” Since Guo only identifies animal models generally, and does not state that any of the animal models are “in need of bone formation promotion,” Applicants respectfully submit that Guo does not inherently or explicitly disclose the recited method. Favorable reconsideration is respectfully requested.

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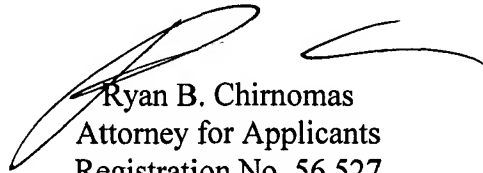
Amendment
Attorney Docket No.: 062043

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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